Supreme Court, U.S.
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No. 08-583

IN THE
Supreme Court of the United States

ENERGIZER HOLDINGS, INC., *et al.*,
Petitioners,

v.

INTERNATIONAL TRADE COMMISSION, *et al.*,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF IN OPPOSITION

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QUESTION PRESENTED

Whether this Court should grant certiorari to review the nonprecedential judgment of a Federal Circuit panel, based on the particular facts of this case, that Claim 1 of Petitioners' patent was invalid under 35 U.S.C. § 112, ¶ 1 or ¶ 2, because the advance in the art invented and described by the patentee is not what the patentee has claimed.

RULE 29.6 STATEMENT

Respondents Golden Power Industries, Ltd., Guangdong Chaoan Zhenglong Enterprise Co., Ltd., Guangzhou Tiger Head Battery Group Co., Ltd., Fujian Nanping Nanfu Battery Co., Ltd., Hi-Watt Battery Industry Co., Ltd., Ningbo Baowang Battery Co., Ltd., Sichuan Changhong Electric Co., Ltd., and Zhongyin (Ningbo) Battery Co., Ltd. state that the parent companies and publicly held companies that own 10% or more of the stock of a party include the following:

a. Golden Power Industries, Ltd.
    i. Golden Power Investments (B.V.I.) Limited
    ii. Golden Villa Ltd.
b. Guangdong Chaoan Zhenglong Enterprise Co.
    i. Huang Peilong
c. Guangzhou Tiger Head Battery Group Co., Ltd.
    i. Guangzhou Battery Factory
    ii. Guangzhou Soap Factory
d. Fujian Nanping Nanfu Battery Co., Ltd.
    i. China Battery Limited
    ii. Fujian Nanping Battery Factory
e. Hi-Watt Battery Industry Co., Ltd.
    i. Rio Assets Limited

ii. The Conqueror Capital Ltd.

iii. Yue Xiu International Development Ltd.

f. Ningbo Baowang Battery Co., Ltd.

i. Rayovac PRC

ii. Ningbo Baowang Investment Co.

g. Sichuan Changhong Electric Co., Ltd.

i. Sichuan Changhong Electronics Group Corporation Ltd.

h. Zhongyin (Ningbo) Battery Co., Ltd.

i. Ningbo Sonluk Battery Co., Ltd.

ii. GP Batteries International Limited

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35 U.S.C. § 112, ¶ 2 ..... *passim*

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INTRODUCTION

The problem confronting Petitioners Energizer Holdings, Inc. and Eveready Battery Company, Inc. (collectively, "Energizer" or "Petitioners") is of their own making.[1] The problem is not, as Energizer would have it, hypertextualism or excessive formalism in the Federal Circuit's approach to claim construction warranting this Court's extraordinary intervention. *Cf.* Pet. 17-18. The problem is simply that Energizer's patent claims went well beyond what the inventor actually invented.

As the Federal Circuit panel majority aptly recognized, the point of novelty that advanced the art in regard to U.S. Patent No. 5,464,709 (the " '709 patent") was a limited pre-screening test described in the specification for selecting zinc powder to be used in manufacturing zero-mercury-added alkaline batteries. Pet. App. 8a, 24a, 29a. Energizer formulated its patent claims, however, in an effort to convert that limited advance in the art to an expansive monopoly covering *all* zero-mercury-added alkaline batteries, regardless of whether the test described by Energizer was utilized in their manufacture. Energizer invented and described a test, but it claimed a battery.

In this "fundamental disconnect," Pet. App. 17a, lie the bases for the Federal Circuit panel majority's unexceptional determination that Eveready's '709 patent is invalid under 35 U.S.C. § 112. This case

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[1] For purposes of recusal, counsel for respondents states that Hogan & Hartson L.L.P. began representing respondents in this matter on June 2, 2003.

involves nothing more than the routine application of settled patent validity principles to the specification and single independent claim of the '709 patent. Energizer drafted the claim language so that it does not claim what is described and taught and what the inventor himself regarded as his invention. The Federal Circuit properly found the patent to be invalid. The petition should be denied.

COUNTERSTATEMENT

1. All alkaline batteries have an alkaline electrolyte, a manganese dioxide cathode, and an anode that contains zinc along with other materials. The zinc in a battery anode, however, tends to corrode over time, in turn causing battery leakage. Battery manufacturers initially solved that problem by introducing some mercury into the zinc anode, because mercury inhibits zinc's corrosion. But disposing of mercury-containing batteries poses certain environmental concerns, leading manufacturers and scientists to explore other means of limiting zinc corrosion.

Basic science presented a number of options, including selecting among existing zinc powder supplies to identify "low-expansion" zinc and selecting among corrosion-inhibiting additives and/or alloys. All of these options were known to and regularly practiced by all of the major battery manufacturers. *See* Ct. App. J.A. 7750-51; *id.* at 8547-49; *id.* at 13589:1-5; *id.* at 13644:6-18.

Energizer nonetheless proclaims that it solved the environmental problem of preventing battery leakage without the addition of mercury. Its achievement in fact was far more modest: a test for

selecting among existing zinc samples to determine which zinc could be used to produce batteries that would not leak. In order to prescreen samples from lots of zinc powder before using powder from those lots in its batteries, an Energizer scientist, Dr. Scarr, devised a "gel expansion test"—a lab test cell in a 500 ml. beaker containing an anode gel with 63 grams of zinc, which gel was discharged for 161 minutes to 15% depth of discharge at 2.88 amps. *See* Pet. App. 24a & n.4.

2. Energizer could have attempted to write a process claim for the use of its test, or even a product-by-process claim for a battery manufactured with zinc identified using the test. Instead, Energizer tried to write a claim that would grant it a monopoly over the entire universe of zero-mercury-added alkaline batteries—including those manufactured without using or even knowing about Dr. Scarr's gel expansion test, the sole inventive concept of the patent. The patent that resulted from Energizer's efforts is a hash.

In prosecuting the applications that led to the issuance of the '709 patent, Energizer initially presented broad claims covering all zero-mercury-added alkaline batteries made with "low expansion zinc." Ct. App. J.A. 2048 (*see, e.g.*, Claim 14). The patent examiner repeatedly rejected these claims as obvious over the prior art and indefinite. *Id.* at 2145, 2148-49, 2202-03, 2389-90. Energizer responded to the examiner's obviousness rejection of claims directed to "low expansion zinc" by reference to its gel expansion test, which the cited references did not

teach.[2] *Id.* at 2210. The examiner ultimately allowed the claims based on Energizer's addition of the gel expansion test as an express limitation. *See id.* at 2214 ("The art of record fails to teach an electrochemical cell * * * compris[ing] an anode gel which expands less than 25% after being discharged at 2,88 A for 161 minutes to 15% depth of discharge * * *"). Thus, in response to the examiner's initial objections, Energizer was forced to surrender any effort to claim an electrochemical cell in which the anode gel was made using "low expansion zinc." *Id.* at 2153-57. Subsequent claims presented by Energizer in the chain of applications leading to and including the '709 patent included the gel expansion test that had been added to overcome the examiner's objection. *See, e.g.*, Ct. App. J.A. 2153, 2184, 2543, 2386.

The Summary of Invention for the '709 Patent refers to four different aspects of the claimed electrochemical cell. In the first, the specification provides that "[t]he cell comprises an alkaline electrolyte, a cathode comprising a metal oxide as the active cathode component, and an *anode* comprised of zinc as the active anode component." Supp. App. 4

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[2] As Energizer's counsel initially acknowledged in connection with the prosecution of the '709 patent's European counterpart: "It is known from the prior art that low expansion zinc removes the need for added mercury in the cell and that the use of indium and an organic corrosion inhibitor also remove the need for added mercury in the cell. The prior art therefore teaches ways in which the necessity for adding mercury can be avoided." Ct. App. J.A. 7507. Energizer later sought to recant its attorney's admission.

(col. 1:64-67) (emphasis added). The next aspect again recites the necessary electrolyte and cathode. *Id.* (col. 2:8-10). But this time, instead of referring to an "anode," the specification refers to "an anode *gel* comprising low expansion zinc." *Id.* (col. 2:11) (emphasis added). The third aspect then reverts back to "anode," while the fourth and final aspect specifies that "the anode is a *gel* comprised of zinc." *Id.* (col. 2:33-34) (emphasis added).

The specification also only describes discharge of an anode gel—not zinc powder on its own. *See* Supp. App. 5 (col. 4:16-18) ("Typically, the anode gel expands when it is discharged and then stored."). But the claim makes clear that the "said zinc anode" of the claimed battery is what "has a gel expansion * * * after being discharged * * *." *Id.* at 8 (col. 10:62-64). Energizer conceded as much in its brief to the Commission below. (*See* Petr.'s App. Br. 25, Jan. 24, 2005) ("The 'has a gel expansion * * *' language modifies 'said zinc anode' and, therefore, must be taken into account when interpreting the claim.").[3]

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[3] In this regard, Energizer's assertions that "[t]he anode of an alkaline battery is powdered zinc," Pet. 36, and its drawing suggesting that the anode consists only of "powdered zinc," *id.* at 3, are misleading. The patent plainly indicates that the anode consists of "a mixture of active anode material, electrolyte, [and] optionally an electrolyte-swellable binder." This mixture is the "anode gel." Supp. App. 5 (col. 3:30-31). And the written description goes on to clarify that all of the anode components—the "powdered zinc," "binder," "optional components," and "an amount of the electrolyte" are combined "to form a gel." *Id.* (col. 4:14-16).

What is now Claim 1 of the '709 patent was added to the application as Claim 45 in an amendment filed in late 1994. Ct. App. J.A. 2386. As originally filed, Claim 45 required that "said zinc anode gel" have the requisite gel expansion (less than 25%) after being discharged for 161 minutes to 15% depth of discharge at 2.88A. . *Id.* at 2387. Energizer later amended Claim 45, however, by deleting the word "gel." *Id.* at 2386, 2400. In remarks accompanying the amendment, Energizer stated that "[c]laim 45 * * * [has] been amended to correct a grammatical error. It is the zinc which is to be tested, *as set forth in the specification.*" Ct. App. J.A. 2402 (emphasis added).[4] The claim now reads:

> An electrochemical cell comprising an alkaline electrolyte, a cathode comprising manganese dioxide as an active cathode component, and an anode gel comprised of zinc as the active anode component, wherein the cell contains less than 50 parts of mercury per million parts by weight of

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[4] Energizer now maintains that its correction of a "grammatical error" in fact effected a substantive alteration, dropping the central noun of the claim—"anode gel"—and substituting zinc. Pet. 6. But as Judge Linn observed in his concurring opinion below:

> If the applicant desired coverage of a battery with zinc having specified properties, it should have written Claim 1 of the '709 patent the way it wrote Claim 1 of its related U.S. Patent No. 5,395,714 (reciting[ ] "[a]n electrochemical cell comprising * * * an anode gel comprised of low expansion zinc which has a gel expansion of less than 25% after being discharged for 161 minutes to 15% depth of discharge at 2.88A"). [Pet. App. 29a-30a (Linn, J., concurring).]

> the cell and said zinc anode has a gel expansion of less than 25% after being discharged for 161 minutes to 15% depth of discharge at 2.88A. [Supp. App. 8 (col. 10:56-64).]

3. Like most of the rest of the battery industry, the China Battery Respondents all brought zero-mercury-added alkaline batteries to market without ever running Energizer's test. And like the other Respondent members of the battery industry, the China Battery Respondents were sued before the ITC for allegedly infringing Energizer's patent.

The trial before the Commission addressed, among other matters, the absence of an express antecedent in Claim 1 for the phrase "said zinc anode." The inventor, Dr. Scarr, was candid: "I think the word 'anode' actually was there in error." Ct. App. J.A. 954.[5] Confronted with the fact that the claim element amended during prosecution, putatively for the purpose of correcting a grammatical error, actually introduced what the inventor regarded as a mistake into the claim, Energizer argued that construing the claim's language as written would

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[5] Energizer removed the testimony containing this critical admission from its Appendix D copy of the Commission's opinion in *Energizer I*, ostensibly based on its claim of confidentiality covering the inventor's testimony. Pet. App. 121a-122a. However, the same passage was included in the *Non*-Confidential Joint Appendix for *Energizer IV* with the following entry in the table of contents: "Commission Opinion dated 10/18/2004 (Confidential Version – Complainants Waive Confidentiality of Their Confidential Business Information on Page 24 of the Commission Opinion)." *See* Ct. App. J.A. 954.

"render the vast majority of the specification" and the "entire invention meaningless." Ct. App. J.A. 10182-83.

The Commission concluded that the '709 patent was invalid for indefiniteness. Ct. App. J.A. 956 ("*Energizer I*"). It rejected Energizer's proposed construction of "said zinc *anode*" to mean zinc *powder*. *Id.* at 953-954. As the Commission explained, construing "said zinc anode" to mean zinc impermissibly reads the word "anode" out of "said zinc anode." *Id.* at 954. The Commission observed that whatever "said zinc anode" means, it must be "discharged" to a specified degree—and zinc by itself is not "discharged." *Id.* at 956. The Commission also rejected Respondents' proposed construction of "said zinc anode" to refer to the previously recited "anode gel," a construction the Commission acknowledged was supported by certain claim language and the specification. Ct. App. J.A. 955. Under that construction, the Commission observed, the anode gel of an actual completed battery—rather than the anode of the test cell—would be subjected to the discharge process described in Claim 1. *Id.*

A Federal Circuit panel reversed. Pet. App. 76a-88a ("*Energizer II*"). The court of appeals found it "apparent that the claim can be construed. In that regard, we conclude that 'anode gel' is by implication the antecedent basis for 'said zinc anode.' " *Id.* at 88a. Energizer undertook no further challenge to the Federal Circuit's decision or to its determination that the antecedent basis for "said zinc anode" was the recited "anode gel."

On remand to the Commission, Energizer recanted its doomsday forecasts about what would attend a

Federal Circuit determination that "said zinc anode" means "anode gel." Now it asserted, instead, that the Federal Circuit's determination had no consequence at all, that the Commission was free to ignore the Federal Circuit's holding, and that the Commission should re-interpret "said zinc anode" to mean zinc—the interpretation rejected by the Federal Circuit in *Energizer II*.

The Commission rejected Energizer's attempt to relitigate the Federal Circuit's decision in *Energizer II*. Pet. App. 48a-70a ("*Energizer III*"). Given the court's holding that "said zinc anode" refers to the "anode gel" of the claimed electrochemical cell, the Commission ruled that "by necessary implication, the [Federal Circuit] rejected E[nergizer]'s construction" of the term. *Id.* at 62a. The Commission concluded that under the Federal Circuit's claim construction, the asserted claims were invalid for failure to meet the written description requirement of 35 U.S.C. § 112, ¶ 1. *Id.* at 64a-67a. The Commission went on to find that even if the '709 patent were valid, the accused articles would not infringe. *Id.* at 67a.

Energizer again appealed the Commission's ruling to the Federal Circuit, which in an unpublished decision affirmed the Commission's determination of invalidity. Pet. App. 1a-30a ("*Energizer IV*"). In separate opinions, Judges Schall and Linn agreed that Energizer's proffered construction of "said zinc anode" would require impermissible claim rewriting. *Id.* at 17a-19a (Schall, J.); *id.* at 29a-30a (Linn, J.). Both judges agreed that the claim as written was at odds with the specification, and both judges agreed

that these problems rendered the patent invalid under 35 U.S.C. § 112. *Id.* at 3a-30a.

Judge Schall began by rebuffing Energizer's attempt (again) to relitigate the prior Federal Circuit panel's construction of Claim 1. Pet. App. 14a-17a. Judge Schall explained that the prior panel plainly *did* construe the claim term "said zinc anode," when it concluded that " 'anode gel' is by implication the antecedent basis for 'said zinc anode.' " *Id.* at 17a (quoting *Energizer II*, 435 F.3d 1366, 1371 (Fed. Cir. 2006)). Energizer's insistence that "said zinc anode" denotes "the zinc used to manufacture the 'anode gel' in the battery cell" thus "squarely contradicts" the Federal Circuit's claim construction. Pet. App. 17a. Because the prior panel concluded that "said zinc anode" denotes "anode gel," Judge Schall went on, "it means that, as the Commission held, it is the 'anode gel' of the battery cell sold to consumers—not the zinc of the test cell—that is tested in accordance with the parameters of the claim." *Id.*

Judge Schall then concluded that a "fundamental disconnect" existed between the patent claims and the specification. *Id.* The specification, he explained, speaks of a test cell, while the patent claims speak of "the anode of a completed battery." *Id.* But the claims—not the specification—define the right to exclude, and "[a] court cannot remedy for Energizer the gulf that it has created between the claims and the specification by speaking solely of a test cell in the specification while claiming a completed battery in the claims." *Id.* at 18a.

Judge Schall acknowledged and rejected Energizer's argument that construing the claim as

written led to an "illogical result." *Id.* Citing to the Federal Circuit's decision in *Chef America* v. *Lamb-Weston, Inc.*, 358 F.3d 1371 (Fed. Cir. 2004), the judge concluded that, like the claim in that case, Energizer's Claim 1 "unambiguously requires an illogical result"—and like the claim in that case, that illogical result would stand. Pet. App. 19a. It is not the business of the court, he explained, to "rewrite the claim" by ignoring unambiguous language. *Id.*

Judge Schall then concluded that the Commission's determination that the patent failed to satisfy Section 112's written description requirement—a finding of fact—should be affirmed. *Id.* at 23a-25a. The Commission had identified a "major disconnect" between the patent's claims and the specification: the patent *claims* a commercial battery cell, *id.* at 21a-22a, but its specification *discloses* a test cell not referenced in the claims. *Id.* at 23a-24a. The Commission's determination of invalidity for failure of written description accordingly was "neither unsupported by substantial evidence nor tainted by legal error." *Id.* at 25a.

Judge Linn concurred in the result. Pet. App. 27a-30a. Where Judge Schall had found the '709 patent invalid for lack of written description under 112, ¶1, Judge Linn—who self-identified as a critic of Federal Circuit precedents finding a "separate written description requirement" within Section 112, ¶ 1—found the patent invalid under Section 112, ¶ 2. *See* Pet. App. 27a, 30a. As Judge Linn explained, a patent applicant must "particularly point[ ] out and distinctly claim[ ]" the subject matter of his invention—"[a]nd therein lies the problem." Pet. App. 28a. Claim 1 simply cannot be interpreted to be

a battery cell with a massive zinc anode, because it "can hardly be said to reflect what the applicant regarded as his invention." *Id.* at 29a. Nor can the court "rewrite the claim" to cover the applicant's intention. *Id.* Judge Linn accordingly concluded that the claim was "insolubly ambiguous, and thus, indefinite." *Id.* at 29a-30a (citing *Exxon Research & Eng'g Co.* v. *United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001)).

The difference in the panel majority's approaches, as can be seen from their opinions, largely is one of nuance and nomenclature. The written description requirement of 35 U.S.C. § 112, ¶ 1, is designed to ensure that the boundaries of the property right conferred by a patent are clear, so that efficient investment can be made in innovation. *See Festo Corp.* v. *Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731 (2002) ("A patent holder should know what he owns, and the public should know what he does not."). As this Court has explained, the written description requirement maintains the "delicate balance" between inventors, "who rely on the promise of the law to bring the invention forth," and the public, "which should be encouraged to pursue innovations, creations, and new ideas beyond the inventor's exclusive rights." *Id.* (citing *Bonito Boats, Inc.* v. *Thunder Craft Boats, Inc.*, 489 U.S. 141, 150 (1989)).

The definiteness requirement of 35 U.S.C. § 112, ¶ 2, serves the same purpose. As the Court noted in *Markman* v. *Westview Instruments, Inc.*, 517 U.S. 370, 373 (1996), the definiteness requirement was essential to Congress's objective of "secur[ing] to the [patentee] all to which he is entitled, [and]

appris[ing] the public of what is still open to them." *Id.* (quoting *McClain* v. *Ortmayer*, 141 U.S. 419, 424 (1891)). The claim operates to "define[ ] the scope of the patent grant." *Id.* (quoting 3 E. Lipscomb, *Walker on Patents* § 11:1, at 280 (3d ed. 1985)). Where a claim fails to set forth the scope of the patent grant with the requisite definiteness, courts are unable to determine "what the words in the claim mean," a necessary determination for a finding of infringement. *Id.* at 374 (quotation and citation omitted). As with the failure to provide an accurate written description, the failure to set forth claims with definiteness thwarts the "delicate balance" established by Congress between the interests of inventors and the public. *See Festo Corp.*, 535 U.S. at 731.

Although the written description requirement of 35 U.S.C. § 112, ¶ 1, and the definiteness requirement of 35 U.S.C. § 112, ¶ 2, are "two distinct elements" of the statute, see *Markman*, 517 U.S. at 373, they both are essential to ensuring that inventors granted the valuable right of exclusion accompanying a patent grant also make an adequate and full disclosure to the public. And however the problem identified by Judges Schall and Linn is denominated—as a failure of adequate written description or of definiteness—it renders the patent invalid.

Judge Newman dissented from the majority's invalidity conclusions. Pet. App. 31a-47a. No judge on the panel reached the Commission's alternative conclusion that even if the claims of the '709 patent were valid, the patent was not infringed.

Energizer's combined petition to the Federal Circuit for panel rehearing and rehearing en banc was denied without a recorded dissenting vote. Pet. App. 147a-149a. Energizer now has sought review from this Court. Review should be denied.

REASONS FOR DENYING THE WRIT

Energizer's petition asks this Court to conduct a broad-ranging review of general claim construction principles through the prism of this case. It is hard to imagine a case less amenable to the task. To begin with, the question Energizer has presented for review bears little relevance to the actual legal issues raised and decided in this case. The case also turns on a set of highly idiosyncratic facts. And the result reached by the panel below is fully in keeping with this Court's and the Federal Circuit's precedents and, therefore, presents no compelling reason warranting review by this Court.

I. THE QUESTION PRESENTED BEARS LITTLE RELEVANCE TO THE ISSUES ACTUALLY PRESENTED IN THIS CASE.

Energizer's petition presents for review a sweeping question of patent claim construction—namely, whether the "context[ual]" understanding of experts skilled in the art trumps the plain language of a patent claim. *See* Pet. i; *id.* at 16. But much like its deficient patent, Energizer's question presented seeks to convert this case into something that it is not.

The issue presented to and decided by the panel in *Energizer IV* was not one of claim construction—let alone one involving an agreement among experts

regarding the meaning of the claim terms. As it arose from the Commission, the question was directed to the validity *vel non* of the patent in suit. More specifically, the panel was called upon to review the Commission's determination under Section 112 that the '709 patent was invalid—whether for lack of written description, as Judge Schall ultimately concluded, or for the inventor's failure to "particularly point out and distinctly claim" that which he had invented, as Judge Linn found. *See* Pet. App. 4a-25a; *id.* at 27a-30a.

Energizer spends substantial time early in its petition reciting at length various excerpts of certain experts' opinion testimony about how skilled artisans putatively would have "understood" the claim in its '709 patent. *None* of the three opinions comprising the Federal Circuit panel's decision discussed the testimony of the parties' experts. Pet. App. 1a-47a. Nor was the issue addressed in the Commission's decision. *Id.* 48a-70a. And Energizer hardly can be said to have pressed the issue on appeal, referencing the experts' testimony on the meaning of "said zinc anode" only in passing in its briefing below. (Petr.'s App. Br. 28-30.) Simply put, this case is not and has never been about the role of expert testimony in construing claims, despite Energizer's now-prominent treatment of that contention in its petition.

All parties, including Energizer, recognize that the claims as written do not match the written description of the invention. *See* Pet. 36; Pet. App. 22a; Ct. App. J.A. 10182; (Petr.'s App. Br. 28). But even if Energizer properly could characterize that "fundamental disconnect," Pet. App. 17a, as a "claim

construction" issue—or as Energizer now would have it, an issue about the role of expert testimony in construing patent claims—the legal issue identified in Energizer's petition *still* would bear no relevance to the actual facts of this case. For contrary to Energizer's suggestion, the parties' experts did not by a long shot testify or agree that "the only logical construction" of Claim 1 was "a battery with zinc" that "*would* produce an expansion of less than 25% if submitted to the gelling, discharge, heating, etc. testing process." Pet. 7, 15 (emphasis in original). Energizer's own expert testified that the term "said zinc anode" could only mean *the anode gel* of the claimed battery. Ct. App. J.A. 14438-39. Nor was there any agreement among the experts that the claim could be infringed merely if the "zinc anode"—whatever it might be—"would" produce the requisite expansion "if submitted" to the claimed test. Rather, a number of experts testified that the claim as written required the gel expansion test to be run in order for infringement to occur.

Energizer's own experts and the inventor himself agreed that the term "zinc anode" is not synonymous with "zinc powder." As one of Energizer's experts, Dr. Newman, explained: "A zinc anode is composed of various things that make up the whole system; it is different from zinc powder." Ct. App. J.A. 14438. Newman also testified that a zinc anode is a "material that has been formed of zinc, a binder and electrolyte to form a conductive * * * gel[,]" while zinc powder "would mean exactly that, zinc powder." Ct. App. J.A. 14438-39. Similarly, the inventor, Dr. Scarr, testified that, typically, an anode in a battery "contains zinc powder, an electrolyte, usually, in this case potassium hydroxide, aqueous electrolyte, and a

gelling agent which will hold the whole mass immobile to make it, sort of a paste out of this." Ct. App. J.A. 10334.

It simply is not true, then, that the broad legal issue presented in this case is whether a court may ignore "what skilled artisans recognize as the intended and only logical meaning" in favor of the plain text of the claim terms. Pet. i. To the extent the parties' expert testimony is relevant at this stage, that testimony at best presents a decidedly factual dispute regarding what one skilled in the art would understand the term "said zinc anode" to mean in the context of the patent.

Glossing over these inconsistent factual approaches, Energizer glibly suggests that "[t]he anode of an electrochemical cell *is* powdered zinc * * *." Pet. 36 (emphasis in original). But it is well past time to offer again the interpretation rejected by the Commission in *Energizer I* and by the Federal Circuit in *Energizer II*. Nowhere does the specification explain what a zinc anode is or equate the term "zinc anode" with "zinc powder." In fact, it does quite the opposite, equating the term "zinc anode" with "anode gel." *See* Pet. App. 105a-115a. And the claim itself makes clear that the "said zinc anode" of the claimed battery is what "has a gel expansion * * * after being discharged * * *." Supp. App. 8 (col. 10:62-64). Energizer conceded as much in its brief in *Energizer II*. (Petr.'s App. Br. 25) ("The 'has a gel expansion * * *' language modifies 'said zinc anode' and, therefore, must be taken into account when interpreting the claim."). Thus, it must be the anode of the battery that is discharged and that has the requisite gel expansion—not zinc

powder alone, or zinc powder in the anode of an unclaimed test cell.

* * *

The two judges comprising the Federal Circuit panel majority recognized that the unmistakable meaning of the claim as issued bears little resemblance to either Dr. Scarr's invention or the description thereof in the specification. But that does not present an issue of "claim construction," and it most certainly does not present the legal question whether purportedly "undisputed" (but actually clashing) expert testimony should govern the claim construction process. Energizer's patent was found deficient under Section 112, not because the majority ignored some universally agreed-upon "common sense construction" of the claim terms, Pet. 12, but because Energizer improperly sought to contort the plain meaning of the claim terms in order to claim more than it had invented. The facts of this case simply do not present an appropriate opportunity for this Court to address the question presented by Energizer for review.

II. THIS CASE PRESENTS A POOR VEHICLE FOR REVISITING CLAIM CONSTRUCTION PRINCIPLES IN ANY EVENT.

Even accepting Energizer's demonstrably fictive theory of the case, the Court should decline Energizer's invitation to reexamine general claim construction principles in the context of this case. The Court regularly encounters—and just as regularly denies—petitions for certiorari raising claim construction issues. Just last Term, for example, the Court in *Stryker Corp.* v. *Acumed LLC*,

128 S. Ct. 615 (2007), declined to take up the invitation to review the Federal Circuit's decision in a case where the question presented was quite similar to the one put forth by Energizer here. 483 F.3d 800 (Fed. Cir. 2007). The disappointed petitioner in the Federal Circuit's en banc decision in *Phillips* v. *AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005), *cert. denied*, 546 U.S. 1170 (2006), similarly sought and was denied certiorari on a claim-construction issue. This case, which involves a patent that suffers from so many quirky defects that the panel below had difficulty agreeing upon which of its various infirmities had invalidated the patent, should meet the same end.

The distinctiveness of this case, as briefly explained above, has its roots in an admitted drafting error: the applicant's use of the phrase "said zinc anode" in Claim 1 without any express antecedent basis earlier in the claim. *See* Supp. App. 8 (col. 10:62-64) ("and said zinc anode has a gel expansion of less than 25% after being discharged"). Rather than pointing to an implied antecedent basis for the term "said zinc anode," Energizer has suggested that the claim term in fact has no antecedent in the claim itself and instead refers to zinc powder that exists not in the claimed battery but, rather, in a test cell that is described nowhere else in the claim. Pet. 6-7. But that is the very interpretation rejected by the Federal Circuit in *Energizer II*, where the court concluded that "'anode gel'" is by implication the antecedent basis for 'said zinc anode,'" Pet. App. 88a, thereby reaffirming the importance of the word "anode" as the central noun of the claim. To further complicate matters, Energizer also argues that its use of the word "anode" constituted an *additional*

drafting mistake; Energizer suggests that the word "zinc powder" should have been used instead of "anode." Pet. 4, 6. And Energizer further suggests that the term "after being discharged" does not require discharge after all but, rather, reflects a "characteristic" or "property" of zinc powder that would be revealed if it were discharged. *Id.*

In other words, this is not a case where there is a single disputed claim term that is in conflict with the specification. Rather, Energizer itself suggests that its Claim 1 is replete with drafting errors that require the claim to be rewritten—almost in its entirety—in order to achieve Energizer's proposed construction. As a result of the foregoing "drafting errors," this case presents a rare instance in which the inventor actually testified at trial that the claim as issued does not describe what he considers to be his own invention. Ct. App. J.A. 954 ("I think that word 'anode' actually was there in error.").

These drafting problems were further compounded by Energizer's litigation-induced efforts to stretch the claims of the patent to cover that which they do not. As noted above, the Patent Examiner repeatedly rejected as obvious Energizer's attempts during prosecution of the patent to claim a *battery* made with low-expansion zinc, forcing Energizer to narrow the claims at issue. After obtaining issuance of the patent as a result of the narrowing of the claims, Energizer now seeks to use the specification (filed with the PTO along with the original, rejected claims) to expand the scope of the patent beyond what the Examiner allowed in an effort to grant itself a monopoly over the entire universe of zero-mercury-added alkaline batteries—sweeping in even

those batteries manufactured without using or even knowing about Dr. Scarr's test. What Energizer actually invented is a test to be run on prior-art zinc powder, and what it ultimately claimed in the patent (after repeated rejections in light of prior art) is a test to be run on the anode of a battery. But because the claim language that Energizer chose describes a test that no battery manufacturer uses and one that has no commercial application, what Energizer seeks to assert against the public is an inherent "characteristic" of zinc powder which does not even require the test to be run in order for infringement to occur.

This case also is unique because Energizer obtained a related patent, U.S. Patent No. 5,395,714, which actually *did* claim a battery with an anode containing "zinc" with the requisite gel expansion after being discharged. *See* Pet. App. 30a (noting that Claim 1 [of the '714 patent] recites "[a]n electrochemical cell comprising * * * an anode gel comprised of low expansion zinc which has a gel expansion of less than 25% after being discharged for 161 minutes to 15% depth of discharge at 2.88A"). This patent—which shows that Energizer knew how to formulate a claim in which the "zinc" as opposed to the "anode" had the requisite gel expansion when it wanted to—was *disclaimed* by Energizer on September 3, 2002, shortly before it filed its complaint in this case, because Energizer knew that the '714 patent had been invalidated by prior art.

Energizer's current problem, accordingly, is not one caused by the Federal Circuit's purported general stance on claim construction issues; it is an outgrowth of the fact that Energizer's patent is

fraught with inconsistencies. These inconsistencies resulted from Energizer's need to repeatedly narrow the claims in order to overcome prior art—each time moving farther from the invention described in the specification. The patent's inconsistencies were then exacerbated by Energizer's overt attempt to expand the claims after issuance to acquire a monopoly over virtually all zero-mercury-added batteries.

This case thus presents a Texas hat trick of reasons *not* to grant certiorari. The patent was issued under unusual factual circumstances. The patent is deficient or not infringed on multiple grounds, including some the Federal Circuit panel had no need even to reach. The panel's ruling lacks even a majority opinion representing the judgment of more than one judge of the Federal Circuit about the primary source of the patent's deficiencies. And the ruling was unpublished, and thus nonprecedential. For all of these reasons, the case is a demonstrably poor vehicle through which to institute Petitioners' sought-after grand reworking of Federal Circuit claim construction jurisprudence.

III. THE FEDERAL CIRCUIT'S JUDGMENT WAS CORRECT.

Although the two judges constituting the panel majority relied on different legal doctrines to invalidate Energizer's patent, they both recognized the existence of what Judge Schall described as a "fundamental disconnect" between what the patentee claimed and what the specification described, Pet. App. 17a, and both found the patent invalid under 35 U.S.C. § 112. While Judge Schall found the patent invalid under the written description requirement of

35 U.S.C. § 112, ¶ 1, and Judge Linn did so under the definiteness requirement of 35 U.S.C. § 112, ¶ 2, both appropriately premised their conclusions on the principle that a patentee cannot claim something that is entirely at odds with what he invented and described in the specification. Pet. App. at 17a-18a; *id.* at 29a.

Judge Schall noted that Claim 1 fails to comply with the written description requirement of 35 U.S.C. § 112, ¶ 1, because the subject matter described in the claim is not adequately described in the specification:

> In a word, at the root of the written description issue in this case lies the fact that the invention of the '709 patent is a test to pre-screen zincs for use in zero-mercury-added alkaline batteries to be sold to consumers. * * * [T]hat is the invention that is described in the patent specification. However, the claims of the '709 patent were drafted to claim commercial alkaline batteries. * * * The problem in this case is that the specification of the '709 patent does not teach what is claimed, whereas the claims of the patent do not claim what is taught. [*Id.* at 24a] [citation omitted.]

Judge Schall's analysis is in keeping with the language of the statute, as well as case law interpreting the statute. *See, e.g., Univ. of Rochester* v. *G.D. Searle & Co.*, 358 F.3d 916, 927 (Fed. Cir. 2004) (written description requirement mandates that specification describe the subject matter of the invention later claimed to be protected in the claims).

Judge Linn, like Judge Schall, concluded that Claim 1 failed under Section 112, but under paragraph 2 of the statute. As he noted, Dr. Scarr's invention was "a battery cell with an anode containing zinc of a purity determined by use of the disclosed test cell procedure * * *" Pet. App. 29a. But that is not what Claim 1 "particularly point[s] out and distinctly claim[s]." *Id.* Judge Linn therefore concluded that Claim 1 fails to comply with Section 112's definiteness requirement. *See* 35 U.S.C. § 112, ¶ 2 ("The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."). Judge Linn's analysis, too, comported with prior Supreme Court and circuit precedent. *See Allen Eng'g Corp.* v. *Bartell Indus., Inc.*, 299 F.3d 1336, 1349 (Fed. Cir. 2002) ("Where it would be apparent to one of skill in the art, based on the specification, that the invention set forth in a claim is not what the patentee regarded as his invention, we must hold that claim invalid under § 112, paragraph 2."); *see also Western Elec. Mfg. Co.* v. *Ansonia Brass & Copper Co.*, 114 U.S. 447, 452 (1885) ("The scope of letters patent should be limited to the invention covered by the claim; and, though the claim may be illustrated, it cannot be enlarged, by the language and other parts of the specification.").

Whether one chooses (as did Judge Schall) to label the insoluble incongruity between Claim 1 of the '709 patent and its specification a failure of written description or (as did Judge Linn) to call the same deficiency a failure of definiteness, the end result is the same, and the patent is invalid under either or both doctrines. *See Permutit Co.* v. *Graver Corp.*,

284 U.S. 52, 58 (1931) ("As the patentee has thus failed to give in the specification 'a written description' and has likewise failed particularly to point out and distinctly claim the free zeolite bed, as 'the part, improvement, or combination which he claims as his invention or discovery,' the patent is void."). Both elements of the statute prohibit an applicant from claiming that which was not fully and adequately described in the specification.

Energizer cannot sidestep this problem by relying on the specification to suggest a meaning for the claim terms that runs directly counter to the language used by the applicant. *See* Pet. 4, 6-7, 28, 36. As this Court has long held:

> Some persons seem to suppose that a claim in a patent is like a nose of wax, which may be turned and twisted in any direction, by merely referring to the specification, so as to make it include something more than, or something different from, what its words express. The context may, undoubtedly, be resorted to, and often is resorted to, for the purpose of better understanding the meaning of the claim; but not for the purpose of changing it, and making it different from what it is. The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms. This has been so often expressed in the opinions of this court that it is unnecessary to pursue the subject

> further. [*White* v. *Dunbar*, 119 U.S. 47, 51-52 (1886).]

Even if Energizer were correct, moreover, in resorting to the specification to assert that the term "said zinc anode" could be construed to refer to the zinc powder that is selected for use in a battery, rather than the anode gel of the battery itself, the claim still would be invalid for failure to comply with the written description requirement. The specification describes how to discharge and measure the gel expansion of an anode of a test cell; it does not describe how to discharge and measure the gel expansion of zinc powder alone, either before or after it is placed in the claimed battery. *See* Pet. App. 52a (Commission analysis). Nor does the specification describe how to correlate the results of the gel expansion test as applied to an individual zinc powder sample with the gel expansion of the anode gel of the battery. *See id.* at 11a-12a (Federal Circuit reviewing Commission analysis); *id.* at 123a-124a & nn. 11-12 (Commission analysis). Even if Energizer's favored claim construction had carried the day, then, the end result would be the same: the patent is invalid.

CONCLUSION

For the foregoing reasons, the petition should be denied.

Respectfully submitted,

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